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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/180,132    05/24/99    KIM    H    15280-261004

EXAMINER
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HM12/0806

EUGENIA GARRETT WACKOWSKI  
TOWNSEND AND TOWNSEND AND CREW  
TWO EMBARCADERO CENTER  
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SAN FRANCISCO CA 94111

ART UNIT	PAPER NUMBER
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BADIO, B

1616

DATE MAILED:

08/06/99

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.  
**09/180,132**

Applicant(s)

**Kim et al.**

Examiner

**Barbara Badio**

Group Art Unit

**1616**



☐ Responsive to communication(s) filed on \_\_\_\_\_.

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 1 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claims

☒ Claim(s) 1-36 is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☐ Claim(s) \_\_\_\_\_ is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☒ Claims 1-36 are subject to restriction or election requirement.

## Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_.

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

Art Unit: 1616

## DETAILED ACTION

### *Election/Restrictions*

1. Restriction is required under 35 U.S.C. 121 and 372.

This application contains inventions or groups of inventions which are not so linked as to form a single inventive concept under PCT Rule 13.1.

Due to the numbers of variables involved in the claims ( $R_1$ ,  $R_2$ ,  $R_3$ ,  $R_4$ ,  $R_5$  and  $X$ ) and their widely divergent meaning, a precise listing of inventive groups cannot be made. Illustrative of the different inventive concepts may be made by reference to specific Examples (e.g. compounds, uses thereof, pharmaceutical compositions thereof). As for example, the method treating endometriosis using:

- I. Compound 13
- II. Compound 15
- III. Compound 16
- IV. Compound 32
- V. Compound 37
- VI. Compound 38
- VII. Compound 40, etc.

the following compounds of :

- VIII. Compound 13

Art Unit: 1616

- IX. Compound 15
- X. Compound 16
- XI. Compound 32
- XII. Compound 37
- XIII. Compound 38
- XIV. Compound 40, etc.

Applicant is required to elect a single disclosed species (e.g. Example) from under the instant claims.

With the election of a specific exemplified Example (e.g. compound or method of use of said compound) a generic concept will be identified if possible, by the examiner as the inventive group for examination.

The claims herein lack unity of invention under PCT Rule 13.1 and 13.2 since the compounds defined in the claims lack a significant structural element qualifying as the special technical feature that defines a contribution over the prior art. The compounds of the claims contain a 4,9-diene steroid moiety which does not define a contribution over the prior art. The substituents on the steroid ring vary and when taken as a whole result in vastly different compounds. Accordingly, unity of invention is lacking and restriction of the invention in accordance with the rules of unity of invention is proper.

Art Unit: 1616

2. A telephone call was made to Ms. Eugenia Garrett-Wackowski on July 16, 1999 to request an oral election to the above restriction requirement, but did not result in an election being made.

3. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(l).

***Telephone Inquiry Contacts***

4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Barbara Badio whose telephone number is (703) 308-4595. The examiner can normally be reached between 7:30 am and 4 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, José Dees, can be reached on (703) 308-4628. The fax phone number for this Group is (703) 308-4556.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-1235.

  
Barbara Badio  
Art Unit 1616

August 5, 1999